

Trademark Law v. The First Amendment – the Saga Continues

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In recent years, the US Supreme Court found that two provisions of the US trademark law that date back to the 1940s were unconstitutional because they violated the free speech provisions of the First Amendment. In *Matal v. Tam*, it was the law prohibiting registration of disparaging trademarks, and in *In re Brunetti*, it was the law prohibiting registration of immoral or scandalous trademarks.

Now the Court of Appeals for the Federal Circuit has reached a similar conclusion in a less obvious case. In *In re Elster*, decided on February 24, an attorney applied to register the trademark TRUMP TOO SMALL for “T-shirts.” Registration was refused based on a provision that prohibits trademark registration of a name identifying a particular living individual without that individual’s consent (and another ground not ultimately considered on appeal). Elster appealed to the Trademark Trial and Appeal Board (TTAB), which upheld the refusal. Elster then appealed to the Federal Circuit.

The federal government argued that the government interest in protecting state-law privacy and publicity rights outweighed Elster’s First Amendment rights. The court noted that Trump, as a public figure, had no right of privacy-protecting him from criticism in the absence of knowingly publishing false information or doing so with reckless disregard for the truth. The court also said, “The right of publicity does not support a government restriction on the use of a mark because the mark is critical of a public official without his or her consent.”

The court ultimately concluded that the free speech provisions of the first amendment outweighed the government interest and that “[t]he statute leaves the [US Patent and Trademark Office] no discretion to exempt trademarks that advance parody, criticism, commentary on matters of public importance, artistic transformation, or any other First Amendment interests. It effectively grants all public figures the power to restrict trademarks constituting First Amendment expression before they occur.” And so the court reversed the TTAB’s decision and found the trademark TRUMP TOO SMALL to be registrable.

In reaching its decision, the court made clear that it was not concluding that the relevant section of the trademark law is overbroad, saying it was leaving that question for another day. Rather, it was saying that the application of the law to Elster’s trademark was in violation of his First Amendment rights. Still, this leaves the door open for other trademark applicants for such marks that are parody or critical commentary to raise the overbreadth challenge in the future.

Are you considering adoption of a trademark that includes the name of a living individual? For guidance on the evolving state of the law as it applies to your situation, contact Laura Winston at lwinston@offitkurman.com or 347-589-8536.